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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,945	10/25/2001	David K. Platner	60130-1220/01MMRA0210-CIP	4965

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EXAMINER	
NGUYEN, TRINH T	
ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 02/12/2003

CARLSON, GASKEY & OLDS
FEB 15 2003
RECEIVED

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/056,945	PLATNER, DAVID K.	
	Examiner	Art Unit	
	Trinh T Nguyen	3726	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 4, 7, and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Moses (US 6,122,948).

For claim 1, Moses discloses a method of forming a tubular axle comprising the steps of: providing a cylindrical hollow workpiece/member (40) having an end portion (41); forming the end portion to provide a first generally circular end (see Figures 3-6); and welding a preformed kingpin boss (42) to the generally circular end (see lines 60-65 of col. 4).

For claim 4, note that Moses' method does include forming the end portion into a generally frustroconical shape (see Figures 7-9, and 13-15).

For claim 7, Moses discloses a method of forming a tubular axle comprising the steps of: providing a cylindrical hollow workpiece/member (40) having an end portion (41); forming the end portion to provide a kingpin boss (42); and bending the hollow member to a desired shape (see lines 65-67 of col. 5 and lines 1-5 of col. 6).

For claim 8, note that Moses' method does include forming the hollow member into a generally polygonal cross-section (see Figures 3, 7, 10, 13).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moses (US 6,122,948).

For claim 2, regarding the "bending" step see claim 7 above and regarding to the limitation that the "bending" step is performed subsequent to step c) (i.e., welding step) it is noted that whether the assembly step occurs in a particular order, such as prior to or subsequent to or after another assembly step, is a matter of design choice wherein on stated problem is solved, or any new or unexpected result achieved by performing the step in the order claimed versus the order taught by Moses, and it appears that the invention would perform equally well with the step conducted in any particular order.

For claim 5, regarding the "forming" step see claim 8 above and regarding to the limitation that the "forming" step is performed after step a) (i.e., providing step) it is noted that whether the assembly step occurs in a particular order, such as prior to or subsequent to or after another assembly step, is a matter of design choice wherein on stated problem is solved, or any new or unexpected result achieved by performing the step in the order claimed versus the order taught by Moses, and it appears that the invention would perform equally well with the step conducted in any particular order.

For claim 10, Moses discloses the claimed invention except for specifying that the hollow member has a multi-wall thickness length. However, it is the Examiner's position that such aforementioned limitations are considered as a matter of design choice, wherein no significant problem is solved or unexpected result obtained, and it would appear that the wall thickness length in Moses' hollow member would perform equally as well as.

5. Claims 3, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moses (US 6,122,948) in view of Ishikawa (US 6,305,430).

For claims 3, 6 & 9, Moses discloses the claimed invention except for inserting a bulkhead into a cavity of a workpiece/hollow member. Ishikawa teaches a method of inserting a bulkhead (21, 25, 50, 55) into a cavity of a workpiece/hollow member (18, 19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Moses' method to have included the step of inserting a bulkhead into the cavity of Moses' workpiece/hollow member (40, 50, 60, 70), in a similar manner as taught in Ishikawa, in order to provide an additional reinforcement to the workpiece/tubular member.

Regarding the limitation that the "inserting" step is performed prior to step b) (i.e., forming step) as claimed in claims 3, 6 & 9, it is noted that whether the assembly step occurs in a particular order, such as prior to or subsequent to or after another assembly step, is a matter of design choice wherein on stated problem is solved, or any new or unexpected result achieved by performing the step in the order claimed versus the order

taught by Moses, and it appears that the invention would perform equally well with the step conducted in any particular order.

For claims 6 & 9, regarding the "forming" step see claim 8 above and regarding to the limitation that the "forming" step is performed prior step b) (i.e., forming step) it is noted that whether the assembly step occurs in a particular order, such as prior to or subsequent to or after another assembly step, is a matter of design choice wherein on stated problem is solved, or any new or unexpected result achieved by performing the step in the order claimed versus the order taught by Moses, and it appears that the invention would perform equally well with the step conducted in any particular order.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-10 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/935,026. Although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1 & 2 of the copending Application No. 09/935,026 "anticipate" claims 1 & 7 of the application. Accordingly, the copending application 09/935,026 claims 1 & 2 are not patentably distinct from the application claims 1 & 7, since the copending application 09/935,026 claims 1 & 2 require elements (i.e., providing a non-circular tubular member having an end portion, forming the end portion to provide a first generally circular end, providing a kingpin boss with a second generally circular end, friction welding the ends together, and bending the tubular portion to a desired shape subsequent to friction welding the ends together) while the application claims 1 & 7 only require elements (i.e., providing a cylindrical hollow member having and end portion, forming the end portion to provide either a first generally circular end or a kingpin boss, and either welding a preformed kingpin boss to the generally circular end or bending the hollow member to a desired shape). Thus it is apparent that the more specific copending application 09/935,026 claims 1 & 2 encompass the application claims 1 & 7. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been filed an application or granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second application or patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form PTO-892 encloses herewith.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich can be reached on (703) 308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ttn
February 9, 2003

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700